

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT:	Roizman, et al.))
SERIAL NO.:	10/530,774)	EXAMINER: Mosher, M.
FILED:	11/17/2005)	ART UNIT: 1648
FOR:	Targeting of Herpes Simplex Virus to Specific Receptors)	

VIA EFS

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

THIRD PARTY SUBMISSION UNDER 37 CFR § 1.99

Dear Sir:

It is hereby requested that a third party submission under 37 CFR §1.99 be entered into the file of United States Patent Application Serial No. 10/530,774 ("the above-identified application"). The third party requests that the Examiner for the above-identified patent application consider as prior art the United States Patent Application Serial No. 10/504,460 (United States Patent Publication No. 2005/0271620). It is believed that the instant submission complies with the requirements of MPEP § 1134.01 and 37 CFR § 1.99 and that the above-identified patent application is still pending.

In accordance with MPEP § 1134.01, the following is provided:

- (1) The fee set forth in § 1.17 (p) of \$180;

- (2) A list of patents or publications submitted for consideration by the Office, including the date of publication of each patent or publication. The list follows below:

- a. United States Patent Publication No. 20050271620, published December 8, 2005;
- (3) A copy of each listed patent or publication in written form;
- (4) An explanation believed to be satisfactory for the delay for filing the instant submission outside of the permitted two months from the publication date of the above identified application of March 30, 2006;
- (5) The fee set forth in § 1.17 (i) of \$130; and
- (6) Proof of service on the attorney of the above-identified application.

An English language translation is not provided as it is unnecessary for a United States patent publication in the English language. No explanations of relevance are provided. The submission contains less than ten total patents or publications.

The above-identified application was published on March 30, 2006. According to 37 CFR § 1.99, a submission under 37 CFR § 1.99 must be filed within two months from the date of publication of the application or prior to the mailing of a notice of allowance, whichever is earlier; but any submission under this section not filed within this period is permitted when the patents or publications could not have been submitted to the Office earlier, and accompanied by the processing fee set forth in § 1.17(i) of \$130. It is noted that MPEP § 1134.01 provides that under at least one circumstance, such as, “an amendment submitted in the application after publication changes the scope of the claims to an extent that could not reasonably have been anticipated by a person reviewing the published application during the period specified in 37 CFR § 1.99(e),” untimely submissions will be entered. MPEP § 1134.01 requires that a satisfactory explanation for the delay must be provided.

Entry of the instant submission is respectfully requested despite the expiration of the two-month date for the reason that the instant submission could not have been submitted to the Office earlier. The above-identified application was published in the United States on March 30, 2006, in which claim 35 read:

35. (Original) A method of killing a target cell, comprising contacting the target cell with a recombinant HSV particle, wherein the HSV particle comprises an altered gD forming a fusion with a peptide ligand to a receptor specific to the cell.

In February 2008, original claim 35 was still pending. It is submitted that under current claim construction practice, Claim 1 of the above-identified application was narrower than claim 35. In the office action of March 4, 2008, the Examiner indicated claim 35 would be allowable if amended to overcome the § 112 rejections - but exactly what amendment should and would be made was not made clear, so it could not have been predicted what the amended claim would look like. The Applicant of the above-identified application presented the following claim in response to the March 4, 2008 rejections:

35. (Currently amended) A method of killing a target cell, comprising contacting the target cell with a recombinant HSV particle, wherein the HSV particle comprises an altered gD forming a fusion with a peptide ligand to a receptor specific to the cell wherein the altered gD exhibits reduced binding to at least one of the cellular receptors of wild type gD.

It is submitted that the amendment made to claim 35 in response to the Office Action of March 4, 2008 has changed the scope of the claims in a way that could not have been reasonably predicted when looking at the published application in March 2006, or in light of the Office Action of March 4, 2008. There were no dependent claims for claim 35 as originally filed.

Accordingly, it is submitted the amendment to claim 35 in July 2008 changed the scope of the claims to an extent that could not have been anticipated by a person reviewing the published application during the period specified in 37 CFR § 1.99.

The processing fee set forth in § 1.17(i) of \$130 is included.

In summary, entry of the instant third party submission under 37 CFR § 1.99 into the file of United States Patent Application Serial No. 10/530,774 ("the above-identified application") for consideration by the Examiner is respectfully requested. All requirements under 37 CFR § 1.99 are believed to have been provided.

The undersigned hereby authorizes any deficiency in the fees to be charged to deposit account No. 19-5117.

Respectfully submitted,

Date: Jan. 28, 2009


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37 CFR §1.248
Certification of Service of Papers

I hereby certify that a copy of the correspondence containing the information being submitted to the USPTO in the instant submission has been served via the United States Postal Service as first class mail in an envelope addressed to the attorney of record:

Marshall, Gerstein, and Borun LLP
233 South Wacker Drive
Suite 6300 - Sears Tower
Chicago, Illinois 60606-6357

on January 28, 2009.

Signature: Mary Breen Smith
Name: Mary Breen Smith, Reg. No. 43,512